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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,769	03/09/2000	Peter C Johnson	99-40165-US	3731

7590

09/30/2002

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EXAMINER

MARSCHER, ARDIN H

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 09/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/521,769

Applicant(s)

Johnson

Examiner

Ardin Marschel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 9, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) 10-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Jul 9, 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Applicant's arguments, filed 7/9/02, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 1-9 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment to claim 1, part (c), which deleted the three lines therein directed to relating the uniform end product result to the associated product processing feature range set has caused the claim to now be broader than the disclosure as filed and correspondingly contain NEW MATTER. Applicant pointed to the specification on page 28, lines 19-26, and Figure 6 for written support for this amendment. Consideration of both said page 28 citation and Figure 6 reveals that these disclosures do not disclose the present claim 1, lacking steps (d) and (e). The entirety of claim 1 basis must be considered and not an excerpt therein for support. Considering the steps (d) and (e) of claim 1 reveals that further description of the invention is set forth on page 28, line 28, through page 29, line 15. This page 28-29

citation gives written basis for said parts (d) and (e) of claim 1 but also includes the requirement that has been deleted from claim 1, part (c), which relates the end product to the indices or product processing features. Thus, the invention as set forth in claim 1, when considered regarding all of its parts which are still in claim 1 reveals that the deletion in part (c) of claim 1 changes the invention over what was submitted as filed and therefore causes claims 1-9 to contain NEW MATTER due to the NEW MATTER in claim 1. This rejection is necessitated by amendment.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5-9 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Chtioui et al. (already of record).

This rejection is reiterated from the previous office action, mailed 4/9/02. Applicant's submission of the Jan, 1998, publication date for this reference is appreciated and acknowledged which thus results in this being only a rejection under 35 U.S.C. § 102(b). Applicant argues that non-random selection of raw product is not taught in the reference. In

response the actual claim steps also lack any non-random limitation. Non-random is only in the preamble of claim 1 and, as not being reflected in the actual claim steps, is not deemed a required limitation for anticipating the actual performance of the claimed method. Thus this argument is non-persuasive. It, however, noted that even if a specific non-random limitation were to be amended into one or more claim steps that the rejection would still be maintained because Chtioui et al. selects raw products which are specific such as seeds in the abstract. Clearly the selection of specific items such as seeds is non-random. A random selection would not be able to even name what is to be selected beforehand. Applicant then argues that the reference is aimed at keeping diversity rather than uniformity. In response this argument is not understood because no two items ever can be exactly the same but always has some diversity between them. Thus some diversity as in the quotation argued by applicants from page 78 of the reference does not indicate whether or not that the end product of a process is uniform within expected parameters, or not, as is reasonably interpreted regarding the practice of the instant claims as well as in the reference. Applicant then points to further citations in the reference of product variance but also include the allowed discrimination of wild oat seeds from other seed species which is still deemed a uniformity of end product regarding at least this

characteristic. It is noted that the instant claims do not require that the end products be all exactly the same but rather uniform without limitation as to what uniformity is meant. Applicant then argues that product processing records which associates product processing data with a corresponding product processing feature range set has not been pointed to in the reference. In response the previous office action pointed to pages 82-86 of the reference wherein "Seed Appearance" and seed features were related to, or associated with, the expected seed product character upon end product processing. Applicant is reminded that product processing is deemed to include examination in order to define characteristics of the seeds. Applicant then argues that step (a) is not disclosed in the reference and so step (d) cannot also be disclosed. In response sample seeds are provided as in instant step (a) and these are then assessed for suitability for being the desired end product oat seeds. In summary, applicant's arguments have not been persuasive.

No claim is allowed.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS

OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This application contains claims 10-42 drawn to an invention non-elected without traverse in Paper No. 9, filed 11/29/01. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

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Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

September 26, 2002

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER